The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES T. O'CONNOR

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Appeal No. 1997-3843
Application No. 08/221,030

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ON BRIEF

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Before JERRY SMITH, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a first order tuning circuit for a phase-locked loop. An understanding of the invention can be derived from a reading of exemplary claim 1[1], which is reproduced below.

1. A phase-locked loop circuit, comprising:

a clock input for receiving a data clock signal having an input frequency;

a voltage controlled oscillator for generating a VCO output clock signal having an output frequency controlled by a voltage across a capacitor;

a tuning circuit for generating first and second control signals in response to the input frequency of the data clock signal and the output frequency of the VCO output clock signal; and

means for applying both the first and second control signals to the capacitor to apply and remove charge to the capacitor proportional to the phase overlap between the first and second control signals.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Nishita et al. (Nishita)	5,052,022	Sep. 24, 1991
Pearson	5,276,712	Jan. 04, 1994

[1] The examiner indicated in the answer at page 2 that the amendment after final rejection, filed on Feb. 27, 1997, has been entered. We note that this amendment was actually filed on Feb. 12, 1997 with the Appeal Brief and has not been officially entered in the file wrapper. No Advisory action was mailed in response to the amendment. Since the examiner has expressly indicated that the amendment was entered, we consider claim 1 as amended.

Claims 1, 2, and 7-12 stand rejected under 35 U.S.C. § 102 as being anticipated by Nishita. Claims 3-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishita in view of Pearson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed May 13, 1997) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed Feb. 12, 1997) and reply brief (Paper No. 16, filed Jul. 17, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in claim 1. The language of the claim recites a “means for applying both the first and second control signals to the capacitor to apply and remove charge to the capacitor proportional to

the phase overlap between the first and second control signals." Appellant argues that Nishita does not teach two control signals applied to the capacitor to apply and remove charge proportional to the phase overlap between the first and second control signals. "Overlap" as a noun is defined as "a part or portion that overlaps or is overlapped." As a verb, "overlap" is defined as "to lie or extend over and cover part of"; or "to have an area or a range in common with."[2] Appellant argues that an important difference between Nishita and the present invention is that the control signals of Nishita are never allowed to be high at the same time. Appellant further identifies Figure 7A of Nishita to show that the two control signals are never both in the high state at the same time. (See brief at page 13.) We agree with appellant that Nishita does not teach the two signals overlap, therefore, any control therefrom could not be proportional to the overlap of the two signals. Therefore, the examiner has not set forth a **prima facie** case of anticipation, and we cannot sustain the rejection of claims 1, 2, and 7-12.

With respect to the rejection under 35 U.S.C. § 103, the examiner relies on Pearson to teach the use of a clock signal which has been divided down to a lower frequency, but the examiner does not rely upon Pearson to teach or suggest the claim limitation concerning the proportional control. From our review of Pearson, we find that Pearson does not

[2] *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation.

remedy the above noted deficiency. Therefore, we cannot sustain the examiner rejection of claims 3-6 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, and 7-12 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 3-6 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

JD/RWK

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